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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,989	03/30/2006	Heinz Von Der Kammer	2335.0140000/SRL/KPQ	9161

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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WASHINGTON, DC 20005

EXAMINER

HIRIYANNA, KELAGINAMANE T

ART UNIT	PAPER NUMBER
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1633

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	02/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/573,989

Applicant(s)

VON DER KAMMER ET AL.

Examiner

Kelaginamane T. Hiriyanna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

The inventions as claimed are classified into following groups:

- I. Claims 1-4, 15, 17-18, 28, and 30 drawn to a method of diagnosing neurodegenerative disease comprising determining the level and/or an activity of a) transcription of cytosolic sulfotransferase family 4A member1 or b) a translation product of said transcript or c) a fragment of said transcription or translation product, and to a kit for diagnosing or prognosticating said neurodegenerative disease in a subject.
- II. Claims 5, and 19 drawn to a method of treating or preventing a neurodegenerative disease by gene therapy with a gene coding for cytosolic sulfotransferase family 4A member1 and/or a transcription product of said gene and/or a translation product of said transcript and/or a fragment or variant said gene, transcript or translation product.
- III. Claims 6-10, 20-24 drawn to a genetically altered non-human animal comprising a transgene coding for cytosolic sulfotransferase family 4A member1 or a fragment, or a derivative or a variant thereof and to a method of screening or testing compounds etc using said animal.
- IV. Claims 11-13,16, 25-26 and 29 drawn to a method of screening for a modulator of a neurodegenerative diseases or related diseases or disorders or one or more substances consisting of a gene coding for cytosolic sulfotransferase family 4A member1 or a fragment, transcription

product, translation product and a fragment or derivative or a variant thereof.

- V. Claims 14, 27 drawn to an assay for testing a compound for inhibition of binding between a ligand and a cytosolic sulfotransferase family 4A member1 protein or a fragment or a derivative or a variant thereof.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: a) a prior art of record exists regarding a feature that links technical claims 1-30 i.e., cytosolic sulfotransferase family 4A member1 gene, gene products and their use and b) further Group I invention is specifically designed for a diagnostic method of disease, Group II invention involves a method of therapy or treatment of a disease, Group III invention involves generation of a transgenic animal and its use, Group IV is drawn to a method of screening of modulator of a neurodegenerative disease where as Group V involves an assay for compound that inhibits an interaction between a ligand and the protein of a cytosolic sulfotransferase family 4A member1. The mode of operation, and the effects evaluated in each of the above invention is thus distinct and different from the other. The invention as whole thus lacks unity under PCT rule. Therefore, a search and examination for the patentability of the above inventive groups together would generate an undue search burden on the examiner. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Kelaginamane Hiriyanne* whose telephone number is (571) 272-3307. The examiner can normally be reached Monday through Friday from 9 AM-5PM. Any inquiry concerning this communication or earlier communications regarding the formalities should be directed to Patent Analyst *William N. Phillips*, whose telephone number is (571) 272-0548. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Joseph Woitach*, may be reached at (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). When calling please have your application serial number or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. For all other customer support, please call the USPTO call center (UCC) at (800) 786-9199.

Kelaginamane T. Hiriyanne

Patent Examiner

Art Unit 1633



SUMESH KAUSHAL, PH.D.
PRIMARY EXAMINER

